

REMARKS

STATUS OF THE CLAIMS

Claims 66-71 and 125-128 as previously pending were appealed to the Board of Patent Appeals (Appeal No. 2008-0404). In a Decision dated September 15, 2008, the Examiner's rejection based on 35 U.S.C. § 102(b) was affirmed.

Pursuant to 37 C.F.R. § 41.50(b), Applicants submit the foregoing amendments and following remarks for reconsideration by the Examiner.

Claim 66 has been amended as shown above to clarify that the claim is drawn to a library of polynucleotides wherein each polynucleotide has an insert consisting essentially of an accessible region of cellular chromatin. Claim 67 has been amended to make explicit that the inserts consists of an accessible region. Claims 68 to 71 have been amended to depend from amended claim 66. Thus, claims 66-71 and 125-128 are pending as shown above.

35 U.S.C. § 102(b)

The rejection of claims 66-71 and 125-128 rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the Clontech Catalogue was affirmed by the Board on the grounds that claim 66 as previously pending was drawn to an individual polynucleotide that that Clontech libraries inherently comprise one or more clones consisting essentially of accessible regions. (Decision on Petition, at page 5).

Claim 66, from which all claims directly or ultimately depend, is now drawn to a library of polynucleotides in which each polynucleotide comprises an insert sequence consisting essentially of an accessible region of cellular chromatin.

As set forth by the Board, the claimed libraries are clearly described in the as-filed specification. Moreover, the Board indicated that libraries as claimed are not inherently disclosed in the Clontech Catalog because the term "consisting essentially of" excludes clones containing only non-accessible regions that would necessarily be found in the Clontech libraries (Decision on Petition, at page 5):

We find that when the Specification is viewed as a whole it discloses that the basic and novel characteristics of the claimed polynucleotides and libraries are that they arise from, and correspond to, accessible regions of cellular chromatin. Throughout the Specification Appellants refer to methods of production of

libraries which do not include only inaccessible regions of chromatin and to polynucleotides and libraries corresponding to accessible regions of chromatin. (See e.g., Spec. 4:27-32 and Spec. 27:13-34.). Thus, we do not agree with the Examiner that on the record before us the term "consisting essentially of" should be construed as equivalent to the term "comprising."

In other words, the rejection was affirmed only because claim 66 was previously drawn to an individual polynucleotide. As noted above, pending claim 66 is drawn to a library and requires that each insert of every polynucleotide of the claimed library consists essentially of an accessible region of cellular chromatin. As determined by the Board, the claimed libraries are not inherently disclosed by Clontech because each and every insert in the Clontech libraries does not consist essentially of an accessible region of cellular chromatin.

Thus, Clontech fails to describe, expressly or inherently, polynucleotides and libraries as claimed. Therefore, the rejection cannot be sustained and Applicants respectfully request withdrawal thereof.

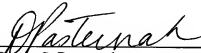
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the claims are now in condition for allowance and request early notification to that effect.

Respectfully submitted,

Date: October 6, 2008

By: _____


Danna S. Pasternak
Attorney for Applicant
Registration No. 41,411

ROBINS & PASTERNAK LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel.: (650) 493-3400
Fax: (650) 493-3440